

REMARKS

Entry of the foregoing, re-examination and reconsideration of the subject matter identified in caption, as amended, pursuant to consistent with 37 C.F.R. §1.112, and in light of the remarks which follow, are respectfully requested.

The specification has been amended to correct an obvious error. It is apparent from Table 8 on page 111 that "Humidity Heat Fastness" refers to evaluation of inks for fastness at a selected temperature and humidity.

Turning to the Office Action, claims 1, 3-15 and 17-20 were rejected under 35 U.S.C. §102(e) as anticipated by Ishizuka et al (published application US 2001/0023267 for the reasons set forth in paragraph (3) of the Action. Reconsideration of this rejection is respectfully requested for at least the following reasons.

The Ishizuka et al publication has a §102(e) date of December 21, 2000. The present application claims priority under 35 U.S.C. §119 of Japanese patent Application Nos. 2000-078518 and 2000-203856, filed March 21, 2000 and July 5, 2000, respectively. Certified English-language translations of these priority applications are submitted herewith. The disclosures of the applications are believed to fully support the subject matter of the present claims.

Accordingly, the §102(e) rejection over the Ishizuka et al published application, should be withdrawn. Such action is earnestly requested.

Claims 1, 3-10, 12-14 and 17-20 were rejected under 35 U.S.C. §103(a) as unpatentable over Ober et al (U.S. Patent No. 4,692,188) in view of Meyrick et al (U.S. Patent No. 6,344,497) and either JP 03231975 or JP 090559552 for reasons given in paragraph (5) of the Office Action. Reconsideration of this rejection is requested for at least the reasons which follow.

The ink compositions of the present invention include a hydrophobic high boiling point organic solvent having a boiling point of 150°C or more. The presence of such a solvent contributes to the overall improved properties of the inks. Ober et al '188 uses a water immiscible organic solvent to facilitate the dispersion of oil soluble dye and polymer in an aqueous phase. The organic solvent is thereafter evaporated. In this regard, note column 4, lines 39-41 and column 8, lines 34-35. Thus, the ink, when used, does not contain the organic solvent.

Ink Sets 103 and 109 (described on page 97 of the specification) represent Comparative Examples of inks which do not contain a high boiling organic solvent, i.e. are comparable to the inks disclosed in Ober et al '188. It is clear from the data in Table 7 on page 110 that Ink Sets 103 and 109 are inferior, i.e. they exhibit poor printing ability (2) and poor over-abrasion properties.

Due to the presence of a hydrophobic high boiling point organic solvent, the inks of the present invention possess enhanced ink absorption onto paper and excellent printing ability (2) and over abrasion properties. The inks of Ober '188 do not contain such a solvent and are inferior to those claimed herein.

The Examiner relies on Meyrick et al '497 for a suggestion of using a hydrophobic organic high boiling point solvent in the compositions of Ober '188. Even assuming *arguendo* that such a substitution was accomplished, the solvent would still be evaporated as required in the invention of Ober '188 and would not be present in the printing inks.

Moreover, the polymer used in the compositions of Meyrick et al '497 is an ionic polymer, specifically, a polyester bearing ionized sulfonate groups. On the other hand, the presently claimed compositions employ nonionic polymers. Applicants have attached a Declaration filed under 37 C.F.R. §1.132 which provides data demonstrating the excellent results obtained using a nonionic polymer as opposed to the ionic polymers used by Meyrick et al '497. The ionic polymer used in the comparative Ink Set in the Declaration is substantially identical to the polymer prepared in Example 1 of Meyrick et al '497 except that "Fascat 4101" was unavailable. Since the amount of "Fascat 4101" used in Example 1 of the reference was quite small, its absence was not expected to affect the results of the evaluation.

JP '975 and '552 are relied upon in the rejection for their disclosures of specific oil-soluble dyes. These documents do not supply the deficiencies of Ober et al '188 as discussed above.

For at least the above reasons, including the attached Declaration, the §103(a) rejection over Ober et al '188 in view of Meyrick et al '497 and either JP '975 or JP '552 should be withdrawn. Such action is earnestly solicited.

Claim 11 was rejected under 35 U.S.C. §103(a) as unpatentable over Ober et al '188 in view of Meyrick et al '497 and either JP 03231975 or JP 09059552 as applied to claims 1, 3-10, 12-14 and 17-20 above, and further in view of Suzuki et al (U.S. Patent No. 5,508,421) for the reasons set forth in paragraph (6) of the Office Action. Also, claim 15 was rejected under 35 U.S.C. §103(a) as unpatentable over Ober et al '188 in view of Meyrick et al '497 and either JP 03231975 or JP 09059552 as applied to claims 1, 3-10, 12-14 and 17-20 above, and further in view in view of Idei et al (U.S. Patent No. 5,302,437) for reasons set forth in paragraph (7) of the Office Action. Reconsideration of these rejections is requested for at least the following reasons.

Suzuki et al '421 is relied upon in the rejection for a disclosure of specific oil-soluble dyes. Idei et al '437 is relied upon in the rejection for a disclosure of an ink-receiving layer containing porous inorganic pigment. Neither of these subsidiary documents supply the deficiencies of Ober et al '188 as enumerated above.

Accordingly, the §103(a) rejections which include Suzuki et al '421 and Idei et al '437 do not establish a *prima facie* case of obviousness and these rejections should be withdrawn. Such action is earnestly requested.

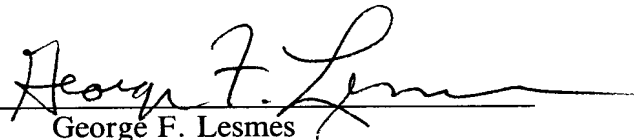
From the foregoing, further and favorable action in the form of a Notice of Allowance is believed to be next in order and such action is earnestly solicited. If there are any questions concerning this paper or the application in general, the Examiner is invited to telephone the undersigned at (703) 838-6683 at her earliest convenience.

Respectfully submitted,

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By: _____



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